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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,975	09/09/2003	John D. VanderWerf	W0686.10.U	2788

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EXAMINER

FIDEI, DAVID

ART UNIT PAPER NUMBER

3728

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/657,975	VANDERWERF ET AL <i>AL</i>	
	Examiner	Art Unit	
	David T. Fidei	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/9/03</u> . | 6) <input type="checkbox"/> Other: ____. |

Claim Construction

1. In analyzing applicant's invention as set out in the pending claims, the examiner sets forth the following to aid in understanding the application of the prior art herein. Claims are to be given their broadest reasonable interpretation during prosecution, see *In re Priest*, 582 F.2d 33, 37 199 USPQ 11, 15 (CCPA 1978), and limitations from the specification will not be read into the claims, see, e.g. *In re Prater*, 415 F.2d 1393, 1404-1405, 162 USPQ 541, 550-51 (CCPA 1969), see § MPEP 2106.
2. In order to further limit the claim there must be some distinction based upon the intended use recited. "However, in apparatus, article, and composition claims, intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art, see M.P.E.P. § 2111.02 THE INTENDED USE MAY FURTHER LIMIT THE CLAIM IF IT DOES MORE THAN MERELY STATE PURPOSE OR INTENDED USE. In the present instant the intended use set out by applicant does nothing to distinguish the present invention over the prior art.

The examiner can see no structural differences between the claimed invention and the prior art based upon a corner protector "adapted to protect a pre-hung door assembly" as recited in claim 1. It appears no distinguishing characteristic, feature or structure is provided by this language. Claim 13 recites a corner guard "adapted to protect a pre-hung door assembly that includes a door secured within a door frame", which further defines subject matter not a part of the claim. The frontal barrier member is recited as affixed across a front corner region of the pre-hung door which would seem to indicate this a combination claim requiring a pre-hung door assembly. The prior art showing corner protector affixed to objects, even though it may not be a pre-hung door, is sufficient to anticipate the claim since the reference is capable of functioning as claimed. However, this contrasts the preamble language where the corner guard adapted (to fit for a specific use) to protect a pre-hung door assembly. Following the broadest reasonable interpretation mandate it would follow that this context is merely a statement of intended use that does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations, see *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 1, 13 and 28 "the other end" has no antecedent basis.

Regarding claims 3, 6, 17, 21, 32 and 36, the phrase "bow-like" or "hook-like" renders the claim indefinite because the claim includes elements not actually disclosed (those encompassed by the "like"), thereby rendering the scope of the claims unascertainable. See MPEP § 2173.05(d).

In claim 13 a corner guard adapted to protect a pre-hung door assembly is recited that makes the scope and content unclear. Is this a combination claim requiring a pre-hung door assembly? The frontal barrier member is recited as affixed across a front corner region of the pre-hung door which would seem to indicate such. However, this contrasts the preamble language where the corner guard adapted to protect pre-hung door assembly. The language is indefinite.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3-9, 12-15, 17-24 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by German document DE 3701293 A1. Regarding claim 1, German document DE 3701293 A1 figure 1 discloses a corner guard 1 comprising: a frontal barrier member having an outer bumper surface 3 and an inner base surface (being the inside surface opposite the surface

having the reference number 3 in figure 1), a fixed side flange 4 affixed to one end of said frontal barrier member 3 and extending approximately perpendicularly with respect to the inner base surface such that a right angle inner surface corner contour is formed therebetween; and an outwardly extensible lip member 8 affixed to the other end of said frontal barrier member.

As to claim 3 said lip member 8 has a proximal end affixed to said frontal barrier member 3; and a free distal end at which said lip member is extensible in a flexible, bow-like manner¹. The lip 8 is bent as shown in figure 1 and meets the definition of a bow.

As to claim 4, the lip member 8 comprises a substantially flat strip member disposed approximately perpendicularly with respect to the inner base surface of said frontal barrier member such that a right angle brace is formed between the inner base surface and the proximal end of said lip member.

7. Regarding figure 3, German document DE 3701293 A1 discloses a corner guard comprising: a frontal barrier member having an outer bumper surface 2a and an inner base surface 2 (see the inverted device of figure 4), a fixed side flange 7a affixed to one end of said frontal barrier member 3 and extending approximately perpendicularly with respect to the inner base surface such that a right angle inner surface corner contour is formed therebetween; and an outwardly extensible lip member 5 affixed to the other end of said frontal barrier member as recited in claim 1.

As to claim 3 said lip member 5 has a proximal end affixed to said frontal barrier member 2a; and a free distal end 3b at which said lip member is extensible in a flexible, bow-like manner. The lip 3b is bent as shown in figure 1.

As to claim 4, the lip member 5 comprises a substantially flat strip member disposed approximately perpendicularly with respect to the inner base surface of said frontal barrier member such that a right angle brace is formed between the inner base surface and the proximal end of said lip member.

As to claim 5, the lip member includes a corner flange 3b at its free distal end.

¹ Bow; 1.a bent, curved, or arched object, dictionary.com

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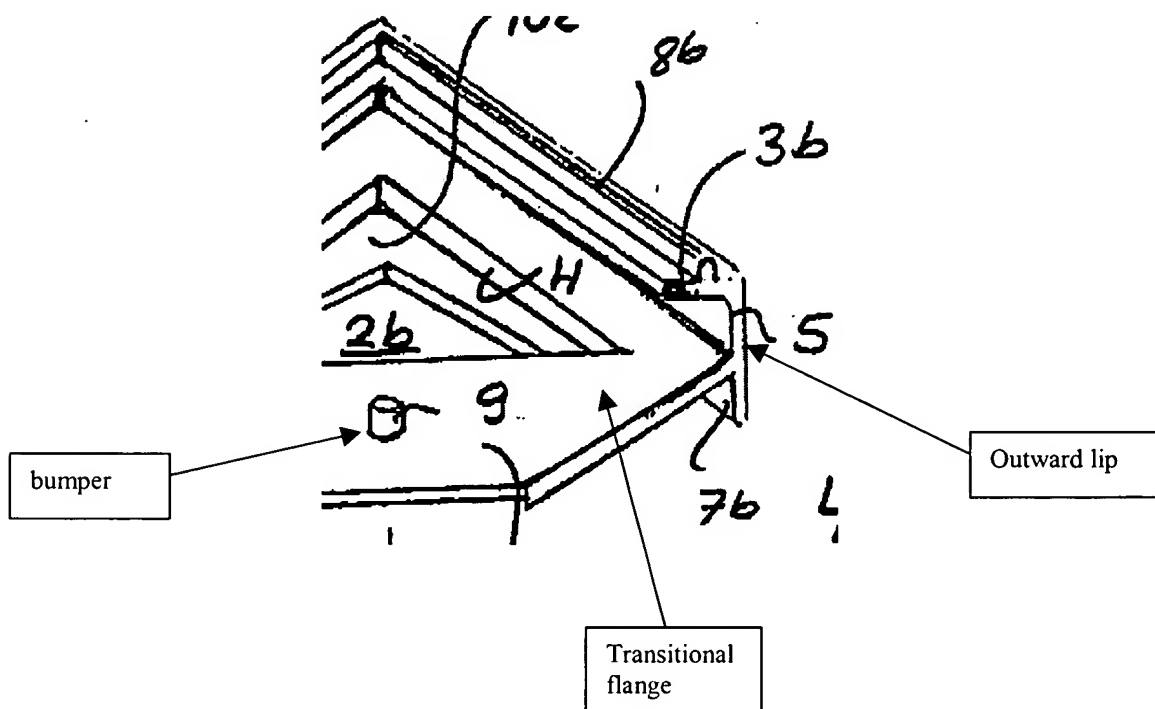
As to claim 6, the lip member corner flange 3b curves inwardly in a hook-like manner as shown in figure 1.

As to claim 7, the frontal barrier member 2 a includes a raised bumper member 9 extending outwardly from the inner base surface to from the outer bumper surface.

As to claim 8, the bumper member includes a substantially flat upper surface.

As to claim 9, the width-to-height ratio of said bumper member 9 appears to be at least 1.0.

As to claim 12, the corner guard includes a substantially flat transition flange that couples said raised bumper 9 member to the proximal end of said lip member 5, see the diagram below.



Regarding claim 13, a corner guard comprising: a frontal barrier member 2a affixed across a front corner region of an object R is disclosed in German document DE 3701293 A1. The frontal barrier member including an outer bumper surface 9 and an inner base surface 2;

a fixed side flange 7a affixed to one end of said frontal barrier member and extending approximately perpendicularly with respect to the inner base surface such that a right angle inner surface corner contour is formed therebetween; and an outwardly extensible lip member 5 affixed to the other end of said frontal barrier member.

As to claim 14, the lip member 5 secures said other end of said frontal barrier member to a corner of the object R.

As to claim 15, the corner guard of claim 13 is recited "wherein said door frame is a three-sided door frame comprising a head jamb and a pair of side jambs wherein the head jamb is coupled at right angle junctions with the side jambs". It is not seen where further defines the corner guard.

As to claim 17, the lip member 5 has a proximal end affixed to the frontal barrier member 2 and a free distal end at which said lip member 3b is extensible in a flexible, bow-like manner.

As to claim 18, the proximal end of said lip member 5 comprises a substantially flat strip member extending approximately perpendicularly with respect to the inner base surface of said frontal barrier member such that a right angle brace is formed between the inner base surface and the proximal end of said lip member.

As to claim 19, the said lip member includes a corner flange 3b at its free distal end for attaching to a corner of the object R.

As to claim 20, the object R has L-shaped corner regions with the lip member corner flange 3b is secured to a corner of a vertical member. Whether it be a bottom corner or top corner of the object depends upon the orientation of the object R, i.e., turned upside-down from the orientation of figure 7 or 12. Which is of no patentable distinctions.

As to claim 21 the lip member 5 corner flange 3b curves inwardly in a hook-like manner.

As to claim 22, the frontal barrier member comprises a raised bumper member 9 extending upwardly from the inner base surface to form the outer bumper surface.

As to claim 23, the bumper member includes a substantially flat upper surface.

As to claim 24, the width-to-height ratio of said bumper member 9 appears to be at least

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As to claim 27, the frontal barrier member further includes a flat transition flange that couples said raised bumper member to said lip member, see the diagram with reference to claim 5.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 28-30, 32-39 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over German document DE 3701293 A1 in view of Admitted prior art (Admission). German document DE 3701293 A1 discloses a corner guard as claimed and extensively described above. The difference between the present claims and German document DE 3701293 A1 resides in a pre-hung door assembly comprising a door secured within a door frame; and four corner guards attached respectively to the four corners of the door frame.

Page 1 of the present specification states a common approach to protecting the areas of a pre-hung door assembly is to install guards at each of the four corner regions, see lines 21-23. German document DE 3701293 A1 teaches a corner guard having the claimed features as extensively described above. It would have been obvious to one of ordinary skill in the art to modify the Admission by providing corner guards as taught by German document DE 3701293

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A1, in order to protect the doors from damage but also provide protection from stacking damage, not figure 6 of German document DE 3701293 A1.

With regard to claim 29 the lip member 5 secures said other end of said frontal barrier member to a corner of the door frame.

With regard to claim 30, as said door frame is a three-sided door frame comprising a head jamb and a pair of side jambs wherein the head jamb is coupled at right angle junctions with the side jambs is conventional in the art and taken to be encompassed by the Admission.

As to claim 32, the lip member 5 has a proximal end affixed to the frontal barrier member 2 and a free distal end at which said lip member 3b is extensible in a flexible, bow-like manner.

As to claim 33 the proximal end of said lip member 5 comprises a substantially flat strip member extending approximately perpendicularly with respect to the inner base surface of said frontal barrier member such that a right angle brace is formed between the inner base surface and the proximal end of said lip member.

As to claim 34 the said lip member includes a corner flange 3b at its free distal end for attaching to a corner of the frame.

As to claim 35, the door frame includes at least one vertical frame member having a bottom end extending in offset manner below the bottom edge of the door to form an L-shaped bottom corner region of the pre-hung door assembly, and wherein said lip member is extensible such that said lip member corner flange is securable to the bottom corner of the vertical frame member.

As to claim 36 the lip member 5 corner flange 3b curves inwardly in a hook-like manner.

As to claim 37, the frontal barrier member comprises a raised bumper member 9 extending upwardly from the inner base surface to form the outer bumper surface.

As to claim 38, the bumper member includes a substantially flat upper surface.

As to claim 39, the width-to-height ratio of said bumper member 9 appears to be at least 1.0.

As to claim 42, the frontal barrier member further includes a flat transition flange that couples said raised bumper member to said lip member, see the diagram with reference to claim 5.

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11. Claims 2, 10, 11, 16, 24, 25, 26, 31, 40 and 41 rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claims 1, 7, 13, 22, 28 and 37 above, and further in view of Marsh et al. As to claims 2, 16 and 31 the difference between the German document DE 3701293 A1 and the claimed invention is that the guard is claimed as an integrally molded unit. Marsh et al col. 5, lines 64-67 teaches a corner guard made as an integrally molded unit. It would have been obvious to one of ordinary skill in the art to modify German document DE 3701293 A1 by constructing the device of as an integrally molded unit as taught by Marsh et al, in order to produce an economical easily manufactured device.

As to claims 10, 11, 24, 25, 40 and 41 relate to the dimension of a part. It would have been an obvious matter of design choice to construct the bumper of any reasonable size desired, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955). Also, it has been held that where the only difference between the prior art device and the claimed device was a recitation of relative dimensions, the claimed device was not patentably distinct from the prior art device, Gardner v. TED Systems, Inc., 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. Denied, 469 U.S. 830, 2325 USPQ 232 (1984), see M.P.E.P. 2144.04 (IV).

REPLY BY APPLICANT OR PATENT OWNER TO THIS OFFICE ACTION

12. “In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to every ground of objection and rejection in this Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. The applicant’s or patent owner’s reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.

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The reply must be reduced to writing (emphasis added)", see 37 CFR 1.111 (b) & (c), M.P.E.P. 714.02.

Pointing out specific distinctions means clearly indicating in the written response what features/elements or distinctions have been added to the claim/claims, where support is found in the specification for such recitations and how these features are not shown, taught, obvious or inherent in the prior art.

If no amendments are made to claims as applicant or patent owner believes the claims are patentable without further modification, the reply must distinctly and specifically point out the supposed errors in the examiner's action and must respond to every ground of objection and rejection in the prior Office Action in the same vain as given above, 37 CFR 1.111 (b) & (c), M.P.E.P. 714.02.


The examiner also points out, due to the change in practice as affecting final rejections, older decisions on questions of prematureness of final rejection or admission of subsequent amendments do not necessarily reflect present practice. "Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c)" (emphasis mine), see MPEP 706.07(a).

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fidei whose telephone number is (571) 272-4553. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David T. Fidei
Primary Examiner
Art Unit 3728

dtf
February 21, 2005